



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,525	09/29/2000	Ronald W. Barrett	019282-000210US	1576

7590 01/18/2005

TOWNSEND and TOWNSEND and CREW LLP  
8th Floor  
Two Embarcadero Center  
San Francisco, CA 94111-3834

EXAMINER
----------

LEFFERS JR, GERALD G

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/675,525

Applicant(s)

BARRETT ET AL.

Examiner

Gerald G Leffers Jr., PhD

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 January 2005. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 23-25 and 34.

Claim(s) rejected: 1-3, 5-9, 11, 12, 22, 26-33, 35-38, 40-42, 44-50, 54 and 127.

Claim(s) withdrawn from consideration: 4, 10, 13-21, 43, 51-53 and 55-126.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit: 1636

***Advisory Action Attachment***

**Continuation of 2. NOTE:** The proposed amendment will not be entered because: the proposed amendment is technically noncompliant in that it does not follow the revised guidelines under 35 U.S.C. 1.121 for amendment practice. Several of the claims comprise an "\*" that is not accounted for as an addition to the previous claim (e.g. by underlining; e.g. see claims 10, 32, 51). Moreover, the proposed amendment introduces new considerations. For example, claims comprising the asterisk are vague and indefinite as to its meaning (elected claim 32). Further, if the amendment were entered and the outstanding grounds of rejection overcome for the broad linking claims drawn to products, additional considerations would arise upon rejoining of the withdrawn claims that are linked by the amended linking claims and methods claims dependent on the product claims (e.g. asterisks in claims 10 & 51; claim 108 not further limiting claim 107). Therefore, the proposed amendment has not been entered .

**Continuation of 3:** Applicants' reply has overcome the following rejection(s): the 112 2nd paragraph rejection made against the phrase "a heterologous nucleic acid tag that can be decoded to identify a characteristic of the compound" is withdrawn. Upon further consideration of the instant specification, and in view of applicants' arguments presented in the response of 1/3/2005, the grounds of rejection made in the previous office action against this phrase are untenable. The cited phrase is merely very broad and is not indefinite.

**Continuation of 5:** The response filed 1/3/2005 does NOT place the application in condition for allowance because: arguments directed to the unentered amendment are moot since the

Art Unit: 1636

amendment has not been entered. If the amendment had been entered, outstanding grounds of rejection for claims 1 and 127 over the prior art would have been overcome. Claim 45 and dependent claims would still be rejected for reasons of record, however, because the limitations of claim 34 have not been incorporated therein. It is noted for the record that the examiner suggested incorporation of the limitations of claim 34 in to claims 1, 127 and 45 (e.g. page 10 of the Final office action mailed 9/29/2004). Also, if the amendment had been entered, rejection of claims 40-42 & 44 under 35 U.S.C. 112 2<sup>nd</sup> paragraph for being dependent on a cancelled claim would have been overcome.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald G Leffers Jr., PhD whose telephone number is (571) 272-0772. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gerald G Leffers Jr., PhD  
Primary Examiner  
Art Unit 1636

ggl

  
GERRY LEFFERS  
PRIMARY EXAMINER